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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/655,353	09/03/2003	Denise R. Barbut	161.700-043	1557
34263	7590	12/15/2005	EXAMINER	
O'MELVENY & MYERS LLP 610 NEWPORT CENTER DRIVE 17TH FLOOR NEWPORT BEACH, CA 92660			ALTER, ALYSSA M	
			ART UNIT	PAPER NUMBER
			3762	

DATE MAILED: 12/15/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

TAK

<b>Office Action Summary</b>	Application No.	Applicant(s)	
	10/655,353	BARBUT, DENISE R.	
	Examiner	Art Unit	
	Alyssa M. Alter	3762	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 25 November 2005.  
 2a) This action is FINAL.                    2b) This action is non-final.  
 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 19,27 and 54-68 is/are pending in the application.  
 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
 5) Claim(s) \_\_\_\_\_ is/are allowed.  
 6) Claim(s) 19,27 and 54-68 is/are rejected.  
 7) Claim(s) \_\_\_\_\_ is/are objected to.  
 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.  
 10) The drawing(s) filed on 03 September 2003 is/are: a) accepted or b) objected to by the Examiner.  
     Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
     Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
 a) All    b) Some \* c) None of:  
 1. Certified copies of the priority documents have been received.  
 2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. _____  |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08).<br>Paper No(s)/Mail Date <u>9/3/03</u> . | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
|  | 6) <input type="checkbox"/> Other: _____                                    |

## DETAILED ACTION

### ***Election/Restrictions***

Applicant's election with traverse of Group II and Species II in the reply filed on November 25, 2005 is acknowledged. Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the requirement is still deemed proper and is therefore made FINAL.

Claims 1-18, 20-26 and 28-53 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected inventions and species, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in the reply filed on November 25, 2005. Therefore, claims 19, 27, 54-68 are now pending in the application.

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

1. Claim 62 rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 62 recites the limitation "method of claim 28". There is insufficient antecedent basis for this limitation in the claim, since claim 28 has been canceled. Therefore, claim 62 has not been further treated on the merits.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

1. Claims 19, 27, 54-56 and 61-64 are rejected under 35 U.S.C. 102(b) as being anticipated by Inoue, M., Nakase, H., Hirabayashi, H., Hoshida, T., Sakaki, T. "Effect of stimulation of the dorsal aspect of the cervical spinal cord on local cerebral blood flow and EEG in the cat." Neurological Research; June 2000; 22(4): 386-392. Inoue et al. discloses the examination of the effect of cervical spinal cord stimulation (SCS) of local cerebral blood flow (CBF). Furthermore, a lead type electrode was utilized for SCS (Pisces-Quad Lead, Medtronic Inc, MN, USA) with a stimulating current generated by a stimulator (Model 3623, Medtronic Inc.).

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

1. Claims 57-60 and 65-68 are rejected under 35 U.S.C. 103(a) as being unpatentable over Inoue, M., Nakase, H., Hirabayashi, H., Hoshida, T., Sakaki, T. "Effect of stimulation of the dorsal aspect of the cervical spinal cord on local cerebral

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blood flow and EEG in the cat." Neurological Research; June 2000; 22(4): 386-392.

Inoue et al. discloses the claimed invention but does not disclose expressly the GRASS stimulator or the rectangular square pulse. It would have been an obvious matter of design choice to a person of ordinary skill in the art to modify the stimulator and stimulation pulse as taught by Inoue et al., with the GRASS stimulator and rectangular square pulse, because Applicant has not disclosed the GRASS stimulator or rectangular square pulse provides an advantage, is used for a particular purpose, or solve a stated problem. One of ordinary skill in the art, furthermore, would have expected the Applicant's invention to perform equally well with Medtronic stimulator or the stimulation pulse as taught by Inoue et al., because the electrical stimulator, regardless of type still provides electrical stimulation. Further the stimulation pulses, regardless of shape are still stimulating the spinal cord and effecting cerebral blood flow.

Therefore, it would have been an obvious matter of design choice to modify stimulator and stimulation pulse to obtain the invention as specified in the claim(s).

As to claims 59-60 and 67-68, while Inoue et al. does disclose a pulse duration of 0.1 msec at a rate of 25 Hz and a voltage of 6V, Inoue et al. does not disclose expressly a stimulation pulse train duration of 10-30 msec or 20 msec, a pulse duration of 1 msec, 50 Hz and 10 V. It would have been an obvious matter of design choice to a person of ordinary skill in the art to modify the electrical stimulation as taught by Inoue et al., with stimulation pulse train duration of 10-30 msec or 20 msec, a pulse duration of 1 msec, 50 Hz and 10 V, because Applicant has not disclosed that the specific values or ranges for the electrical stimulation provide an advantage, is used for a particular purpose, or

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solve a stated problem. One of ordinary skill in the art, furthermore, would have expected the Applicant's invention to perform equally well with the electrical stimulation as taught by Inoue et al., because the specific values of the electrical stimulation utilized by Inoue et al. falls with the ranges specified by the Applicant.

Therefore, it would have been an obvious matter of design choice to modify electrical stimulation to obtain the invention as specified in the claim(s).

Furthermore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the ranges or values of the electrical stimulation, since it has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art. *In re Aller*, 105 USPQ 233 (see MPEP 2144.05).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Alyssa M. Alter whose telephone number is (571) 272-4939. The examiner can normally be reached on M-F 9am to 4pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Angela Sykes can be reached on (571) 272-4955. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

*Alyssa M. Alter*  
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Examiner  
Art Unit 3762

*JEFFREY R. JASTRZAB*  
**PRIMARY EXAMINER**

*WJLJS*